

## II. REMARKS

### A. Status

Claims 1-7 were pending at the time of the first Action, of which claim 1 is independent.

Claims 1-14 are now active for examination, of which claims 1 and 8 are independent.

In the Office Action, claim 4 was objected to for an informality. Office Action at 2. Claims 1, 4, and 5 were provisionally rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claim 1 of co-pending Application No. 11/452,299. *Id.* at 2. Claims 1-3, 6 and 7 were rejected under 35 U.S.C. § 102(b) as being anticipated by Van Oorschot et al. (U.S. Patent No. 6,134,550, hereinafter “Van Oorschot”). *Id.* at 3-6. Finally, claims 4 and 5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Van Oorschot as applied to claims 1 and 3 above, and further in view of Matsuyama et al. (U.S. Patent No. 6,990,583, hereinafter “Matsuyama”). *Id.* at 6-7.

In this amendment, claims 1-6 have been amended to overcome the objections and rejections. New claims 8-14 have been added. Care has been exercised not to introduce new matter. The new claims are product claims where the product comprises at least one medium and instructions for causing one or more processes to perform steps generally similar to steps of method claims 1-7. Support for product terminology should be apparent from the original disclosure (*see e.g.*, page 23, line 6, to page 24, line 13).

### B. Objection to the Claims

In the Office Action, the specification was objected to because in claim 4, line 3 “he” should be replaced by “the.” Office Action at 2. Appropriate correction to claim 4 has been made. Amendment at 2. Withdrawal of the objection is respectfully requested.

**C. Double Patenting Rejection**

Claims 1, 4 and 5 were rejected on the grounds of non-statutory obviousness-type double patenting as being unpatentable over claim 1 of co-pending Application No. 11/452,299 (U.S. Patent Publication No. US 2006/0242413 A1, hereinafter “Fujishiro”). Applicant respectfully submits that amended claims 1, 4, and 5 are not obvious over any pending claim of Application No. 11/452,299, for reasons similar to those that render claim 1 not obvious over applied art, as discussed below. Specifically, the amended claim 1 language includes the limitations of: “...registering the path which has been validated...” and, “...if the checked path is not registered in the database....” Amendment at 2-4.

In contrast, Fujishiro discloses a certificate validity validating server that validates the validity of a public key certificate by (1) searching for a path from a trusted anchor to a certification authority which is the issue origin of a public key certificate; and (2) verifying a detected path. Fujishiro at ¶¶ [0015], [0009], and [0011].

Fujishiro does not teach either of the limitations added to amended claim 1 and nothing in Fujishiro would lead one of ordinary skill in the art that they were an obvious variation thereof. Applicant, therefore, respectfully solicits withdrawal of the rejection of claims 1, 4 and 5 under the judicially created doctrine of obviousness-type double patenting.

**D. Claims Are Not Anticipated**

Claims 1-3, 6 and 7 were rejected under 35 U.S.C. § 102(b) as being anticipated by Van Oorschot. Office Action at 3-7. The rejection is respectfully traversed for the following reasons.

**1. Independent Claim 1 Is Not Anticipated by Van Oorschot**

The invention recited in amended claim 1 is different from Van Oorschot in the following points.

First, the valid paths which have been validated are registered in the database. In claim 1, step 3) recites that very limitation: "...registering the path which has been validated...." *See e.g.*, Amendment at 3. In contrast, Van Oorschot teaches that it is necessary to perform path validation after obtaining the path that satisfies the request condition from the database. Van Oorschot at 5:22-24 and 8:28-35.

Second, if the path of which validation is to be validated is not registered in the database, a path search and path validation is executed anew so as to output an appropriate result, as recited in claim 1, step 6): "if the checked path is not registered in the database...." Amendment at 3. Van Oorschot appears to be silent with regard to the case where the path of which validation is to be validated is not registered in the database.

Hence, Van Oorschot does not disclose either of these limitations of claim 1.

Since Van Oorschot does not teach each and every limitation of the claimed invention, amended independent claim 1 is not anticipated.

**2. Dependent Claims 2-3, 6 and 7 Are Not Anticipated by Van Oorschot**

Of course, a dependent claim cannot be anticipated if the independent claim from which it depends is not anticipated. As discussed above, Applicants respectfully submit that claim 1 is not anticipated. Claims 2-3, 6 and 7 depend from claim 1. Therefore, claims 2-3, 6 and 7 are also not anticipated.

**E. Claims Are Not Obvious**

Claims 4 and 5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Van Oorschot as applied to claims 1 and 3 above, and further in view of Matsuyama. Office Action at 6-7. The rejection is respectfully traversed for the following reasons.

Matsuyama relates to a method of issuing a certificate but does not disclose a method of validating the certificate. Matsuyama at Abstract. Therefore, claim 1 cannot be obvious by merely combining Matsuyama with Van Oorschot because the amended claim language is not taught by Van Oorschot and Matsuyama does not teach the validation of a certificate. Thus, no combination of the two cited references can render claims 4 and 5 obvious.

**F. New Claims Are Allowable**

Claim 8 is a new independent product claim corresponding to existing method claim 1. New claims 9-14 are dependent from claim 8 and correspond to existing claims 2-7. Claims 8-14 have not yet been examined.

Claim 8 would not be anticipated by Van Oorschot for the same reasons that claim 1 is not. The cited reference, Van Oorschot, does not teach that: (1) only the valid paths that are validated are registered in the database; and (2) if the path is not registered in the database, a path search and path validation is executed anew. Accordingly, claim 8 would not be anticipated.

Logically then, claims 9-14 would not be anticipated because they depend from claim 8.

Claims 11 and 12 (which correspond to method claims 4 and 5) would not be obvious over Van Oorschot in view of Matsuyama because of the same reasons that the cited combination does not render claims 4 and 5 obvious. Neither Van Oorschot nor Matsuyama teach certain limitations recited in independent claim 8 (from which 11 and 12 depend) and therefore the combination of the two cannot render claims 11 and 12 obvious.

**III. CONCLUSION**

In conclusion, Applicant respectfully submits that the claims are now in condition for allowance.

**Application No.: 10/788,417**

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read 'D. Spenard', with a stylized flourish at the end.

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